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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,165	09/24/2003	Bruno Rehtziegel	BTK Case 349A	2848
23474	7590	04/22/2005	EXAMINER	
FLYNN THIEL BOUTELL & TANIS, P.C. 2026 RAMBLING ROAD KALAMAZOO, MI 49008-1699			IP, SIKYIN	
			ART UNIT	PAPER NUMBER
			1742	
DATE MAILED: 04/22/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/670,165

Applicant(s)

RECHTZIEGEL ET AL.

Examiner

Sikyln Ip

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 7-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Newly submitted claims 7-9 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6 are, drawn to a filler product, classified in class 420, subclass 486+.
- II. Claims 7-9 are, drawn to a process using the filler product, classified in class 228, subclass 101+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as electrical connector/terminal.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 7-9 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### **Claim Rejections - 35 USC § 103**

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5 are rejected under 35 U.S.C. § 103 as being unpatentable over Gavrov et al (Reference is cited in parent application).

Gavrov disclose(s) the features including the claimed filler alloy composition (abstract). Therefore, when prior art compounds essentially "bracketing" the claimed compounds in structural similarity are all known, one of ordinary skill in the art would clearly be motivated to make those claimed compounds in searching for new products in the expectation that compounds similar in structure will have similar properties. In re Gyurik, 596 F.2d 1012, 1018, 201 USPQ 552, 557 (CCPA 1979); See In re May, 574 F.2d 1082, 1094, 197 USPQ 601, 611 (CCPA 1978) and In re Hoch, 57 CCPA 1292, 1296, 428 F.2d 1341, 1344, 166 USPQ 406, 409 (1970). Therefore, it would have been obvious to one of ordinary skill in the art to select any portion of range, including the claimed range, from the broader range disclosed in a prior art reference because the prior art reference finds that the prior art composition in the entire disclosed range has a suitable utility. Also see MPEP § 2131.03 and § 2123.

With respect to the instant claimed Ni and Mn contents that the differences are very slight that a prima facie case of obviousness would exist where the claimed ranges and prior art do not overlap but are close enough that one ordinary skilled in the art would have expected them to have the same properties, In re Titanium Metals Corporation of America v. Banner, 227 USPQ 773 (Fed. Cir. 1985), In re Woodruff, 16 USPQ 2d 1934, In re Hoch, 428 F.2d 1341, 166 USPQ 406 (CCPA 1970), and In re Payne 606 F.2d 303, 203 USPQ 245 (CCPA 1979). To overcome the prima facie case, an applicant must show that there are substantial, actual differences between the

properties of the claimed compound and the prior art compound. Hoch, 428 F.2d 1343-44, 166 USPQ 406 at 409.

With respect to the claimed impurities that the difference in degree of purity itself does not predicate invention. In re Merz, 38 USPQ 143 and In re King et al, 43 USPQ 400.

With respect to the recited specific MIG application which is not exclude from the generic teaching of welding filler wires.

Claims 1-6 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 04221033 (Reference is cited in parent application) or USP 4830825 to Goto et al (col. 2 lines 1-28).

Cited references disclose the features including the claimed alloy composition. Therefore, when prior art compounds essentially "bracketing" the claimed compounds in structural similarity are all known, one of ordinary skill in the art would clearly be motivated to make those claimed compounds in searching for new products in the expectation that compounds similar in structure will have similar properties. In re Gyurik, 596 F.2d 1012, 1018, 201 USPQ 552, 557 (CCPA 1979); See In re May, 574 F.2d 1082, 1094, 197 USPQ 601, 611 (CCPA 1978) and In re Hoch, 57 CCPA 1292, 1296, 428 F.2d 1341, 1344, 166 USPQ 406, 409 (1970). Therefore, it would have been obvious to one of ordinary skill in the art to select any portion of range, including the claimed range, from the broader range disclosed in a prior art reference because the prior art reference finds that the prior art composition in the entire disclosed range has a suitable utility. Also see MPEP § 2131.03 and § 2123.

With respect to the instant claimed use of the Cu based alloy that "A mere statement of a new use for an otherwise old or obvious composition cannot render a

claim to the composition patentable." (see *In re Zierden*, 411 F.2d 1325, 1328, 162 USPQ 102, 104 (CCPA 1969).

With respect to the claimed impurities that the difference in degree of purity itself does not predicate invention. *In re Merz*, 38 USPQ 143 and *In re King et al*, 43 USPQ 400.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 04221033 (Reference is cited in parent application) or USP 4830825 to Goto et al (col. 2 lines 1-28) as applied to claims 1-5 above, and further in view of Gavrov et al.

The JP04221033 and Goto references disclose the features substantially as claimed as set forth in the rejection above except for the use of the Cu based alloy. However, Gavrov in the abstract discloses the Cu based alloys of cited references are known for solder/filler use in the same field of endeavor or the analogous metallurgical art. It has been held that combining known ingredient having known functions, to provide a composition having the additive effect of each of the known functions is within realm of performance of ordinary skill artisan. *In re Castner*, 186 USPQ 213 (217). The use of conventional materials to perform their known functions in a conventional process is obvious. *In re Raner*, 134 USPQ 343 (CCPA 1962).

As pointed out by the court, *In re Kerkhoven* 205 USPQ 1069, "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose." Cites *In re Susi* 169 USPQ 423, 426 (CCPA 1971); *In re Crockett* 126 USPQ 186, 188 (CCPA 1986).

***Information Disclosure Statement***

The information disclosure statement filed February 20, 2004 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it does not include a concise explanation of the relevance. The crossed-out documents have been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Applicants' remarks in paragraph bridging pages 5-6 of instant remarks is noted. First, said European Search Report cannot be found in record. Second, the said report submitted by applicants with instant remarks is not in English.

***Response to Arguments***

Applicant's arguments filed January 10, 2005 have been fully considered but they are not persuasive.

Applicants' argument in page 6, second full paragraph of instant remarks is noted. But it is found inconsistent with the instant transitional expression "containing" in claim 1, for example, which includes unrecited ingredient even in major amount.



Applicants' argument in page 7, first and second paragraph of instant remarks is noted. But, applicants have not substantiated their position by factual evidence in declaration. Use a filler wire for MIG, TIG, and etc is contemplated within ambit of ordinary skill artisan especially the instant specification fails to provide detailed teaching how the filler composition be used or manufactured.

Applicants argue that the alloys of JP 04221033 and Goto are not used for MIG weld-solder filler. A statement of intended use in the preamble does not impart patentability to a claim to a composition substantially identical to that of the prior art. Ex Parte Head 164 USPQ 664 (POBA 1969). A mere statement of a new use for an otherwise old or obvious composition cannot render a claim to the composition patentable. See In re Zierden, 411 F.2d 1325, 1328, 162 USPQ 102, 104 (CCPA 1969), In re Lemin, 51 CCPA 942, 326 F.2d 437, 140 USPQ 273 (1964), Kropa v. Robie, and Mahlman, 88 USPQ 478 (CCPA 1951). Moreover, use the claimed composition as filler is already known (see Gavrov).

## **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. § 1.121.


#### Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (571) 272-1241. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (571)-272-1244.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
SIKYIN IP  
PRIMARY EXAMINER  
ART UNIT 1742

S. Ip  
April 18, 2005